

TRANSMITTAL LETTER
(General - Patent Pending)

Docket No.
TSR-10002/38

In Re Application Of: **John Hilfinger et al.**

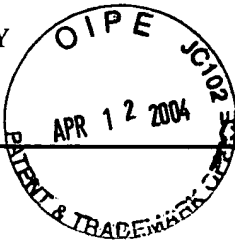
Serial No.
10/706,738

Filing Date
November 12, 2003

Examiner

Group Art Unit

Title: **METHODS AND COMPOSITIONS OF GEGNE DELIVERY AGGENTS FOR SYSTEMIC AND LOCAL THERAPY**



TO THE COMMISSIONER FOR PATENTS:

Transmitted herewith is:

1. Petition to Obtain Filing Date, including attached Declaration of Janice R. Kuehn,
2. Petition Fee of \$130

in the above identified application.

- ☐ No additional fee is required.
- ☒ A check in the amount of \$130.00 is attached.
- ☒ The Director is hereby authorized to charge and credit Deposit Account No. 07-1180 as described below.
- ☐ Charge the amount of
- ☒ Credit any overpayment.
- ☒ Charge any additional fee required.


Signature

Avery N. Goldstein, Reg. No. 39,204
Attorney for Applicant
Gifford, Krass, Groh, Sprinkle,
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280 N. Old Woodward Avenue, Suite 400
Birmingham, MI 48009-5394
(248) 647-6000

Dated:

April 12, 2004

I certify that this document and fee is being deposited on *April 12, 2004* with the U.S. Postal Service as ~~first class mail~~ under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. **EXPRESS MAIL**


Signature of Person Mailing Correspondence

Janice R. Kuehn

Typed or Printed Name of Person Mailing Correspondence

CC:

Serial No. 10/706,738
Petition to Obtain Filing Date

04-13-04

✓



Attorney Docket No. TSR-10002/38

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John Hilfinger et al.

Serial No.: 10/706,738

Filing Date: November 12, 2003

For: METHODS AND COMPOSITIONS OF GENE DELIVERY
AGENTS FOR SYSTEMIC AND LOCAL THERAPY

PETITION TO OBTAIN FILING DATE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with 37 CFR Section 1.53(b), Applicant hereby requests grant of the filing date of November 12, 2003 and the inclusion of the misplaced pages.

Statement of Facts

On November 12, 2003 Applicant filed a utility patent application that is a non-provisional of U.S. Provisional Patent Application No. 60/425,379, filed November 12, 2002. The utility patent application was assigned Serial No. 10/706,738. The utility patent application incorporated by reference the text of U.S. Provisional Patent Application No. 60/425,379. (See page 1 of specification).

The entire patent application transmittal as originally filed is included herewith at Exhibit

A.

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As part of the utility patent application submission a return receipt postcard was provided (transmittal documents, page 2 of 4, item 14). A copy of the return receipt postcard is attached hereto as Exhibit B. The return receipt postcard indicated that the five pages of claims were not received as part of the submission package. A telephone call to OIPE resulted in the recommendation that we delay any inquiry until after image file wrapper capture had been completed.

On February 25, 2004, a paralegal in our office, Janice Kuehn, who had initially worked to prepare the transmittal for the above-referenced utility patent application, entered the Patent Application Information Retrieval system (PAIR) using our customer number and identified not only the omission of five pages of claims according to the return receipt postcard, but also that the specification noted on the postcard as having 27 pages numbered only 12 pages upon image file wrapper capture. Subsequent phone calls were made to Ms. Dalord Dillard and Mr. Kevin Diggs of OIPE in order to request recovery of the original mailing material corresponding to this case in order to locate the missing specification and/or claims pages. These telephone communications attempting to gain additional information from Ms. Dillard and Mr. Diggs have continued from late February 2004 through until April 5, 2004. As of April 5, 2004, no information has been made available to Applicant by OIPE with respect to the content of the original mailing materials.

In light of the acknowledgement provided in the postcard (Exhibit B) indicating the acceptance of 27 pages of specification, Applicant hereby petitions to have the missing 15 pages of specification (pages numbered 13-27 inclusive) restored to the application file.

The declaration of Janice R. Kuehn attached as Exhibit C details the procedure by which the application submission was prepared and is provided to evidence a procedure that makes the

omission from the utility patent application submission packet of fifteen pages of specification or five pages of claims highly unlikely.

As a separate basis for the granting of the filing date of November 12, 2003 to the above-referenced utility patent application is the fact that U.S. Provisional Patent Application Serial No. 60/425,379 was incorporated by reference. The full text of Provisional Patent Application Serial No. 60/425,379 is found at appended Exhibit D. As the instant utility application incorporates by reference this provisional application which itself had patent claims appended thereto, it is submitted that this represents an independent basis for the grant of the original filing date and the subsequent filing of a preliminary amendment to include the missing five pages of claims.

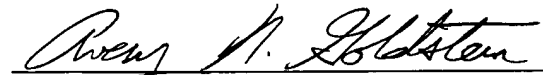
Petition Fee

Provided herewith is a petition fee under 37 CFR Section 1.17(i). Request for a refund of the petition fee is requested if it is determined that the pages of specification numbered 13-27 inclusive and claim pages numbered 28-32 inclusive (corresponding to claims 1-25) are subsequently determined to in fact have been received by the PTO along with the evidence provided herein of such deposit.

Insertion of specification pages 13-27 inclusive of the specification is requested. Acceptance of the missing five pages of claims corresponding to claims 1-25, or an

acknowledgement that through the incorporation of the provisional application including claims that the present application will be accorded a filing date of November 12, 2003 is requested.

Respectfully submitted,



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Attorney for Applicant

ANG/gs
Enclosures


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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

"EXPRESS MAIL" MAILING LABEL NUMBER EV435301302US

DATE OF DEPOSIT April 12, 2004

I hereby certify that this paper or fee (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service "Express Mail Post Office To Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.


Janice R. Kuehn



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: John Hilfinger et al.

Serial No.: 10/706,738

Filing Date: November 12, 2003

For: METHODS AND COMPOSITIONS OF GENE DELIVERY
AGENTS FOR SYSTEMIC AND LOCAL THERAPY

DECLARATION OF JANICE R. KUEHN

Janice R. Kuehn declares as follows:

1. I am a legal assistant for the patent law firm of Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. I have been employed by this firm since November 1996.
2. In my present position I am secretary to patent attorneys Avery N. Goldstein and Angela M. Davison. In that capacity I prepare patent application submission documents to be filed with the U.S. Patent and Trademark Office.
3. In my capacity, when preparing a United States utility patent application, I print final versions of the transmittal pages, application data sheets, specification, claims and abstract. I also assemble the declarations and drawings which may or may not be in digital form. It is a standard procedure that the specification, claims and abstract are all contained within a single document in Word format (Microsoft Corporation). The transmittal pages and application data sheet are prepared using LegalStar IP Forms and EPAVE software from the USPTO, respectively. The computer-printed documents are always the documents submitted to the Patent Office, with copies being made for our file and the client. Thus, if a copying error occurred, it

would appear in our file, not at the Patent Office. In this instant case, the file copy and client copy are complete.

4. In the process of preparing the transmittal papers, necessary to fill out the fee calculation and transmittal fields I prepare a tally of the total number of claims, total number of independent claims, and the numbering of the independent claims. On this same piece of paper I also run a tally of total numbers of pages corresponding to transmittal papers, declaration, application data sheet, specification, claims, abstract and drawings.

5. In preparing to actually mail an application to the United States Patent and Trademark Office I use this tally sheet to finally count the number of pages corresponding to each portion of the submission and further to fill out the return receipt postcard that accompanies the submission. The tally sheet used in this particular patent application submission is attached at Appendix 1 to this declaration. The attached tally sheet includes an error of 28 pages of specification, 5 pages of claims, and one page of abstract. As this tally sheet was used to fill out the transmittal pages, page 1, section 2 noting the specification having 34 pages, the error as to the specification having 28 pages instead of the actual number of 27 appears in the line stating that the specification has 34 pages. Additionally, the total pages in the submission noted as being 52 in the upper left-hand corner of the transmittal pages indicating 52 pages is likewise in error based on a miscount at the tally sheet stage of the submission preparation.

6. The final document of the submission package I complete is the return receipt postcard for which I perform a separate count of specification pages, claim pages, pages of abstract, and drawing pages. While it is certainly possible as happened in this case that a one page discrepancy in a specification may not be caught in this final count, I cannot imagine a

scenario by which an entire section, namely five pages of claims constituting the full set of claims, would be omitted from a utility patent application submission.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the subject patent.

Date: April 12, 2004

Janice R. Kuehn
Janice R. Kuehn

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